

NEIFELD IP LAW, P.C.
2001 Jefferson Davis Highway
Suite 1001, Crystal Plaza 1
Arlington, VA 22202



62 AP/2/83
Tel: 703-415-0012
Fax: 703-415-0013
Email: rneifeld@Neifeld.com
Web: www.Neifeld.com

TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Attorney Docket No.: CAT/34-SCRO-CCP
Application Serial No.: 09/505,632
Filed: 02/16/00
Title: SYSTEM AND METHOD FOR DISTRIBUTING
INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES
Inventor: MICHAEL C. SCROGGIE, et al.
Group Art Unit: 2163
Examiner: AKIBA ROBINSON-BOYCE

RECEIVED

JUL 14 2004

GROUP 3600

RECEIVED

JUL 07 2004

Technology Center 2100

SIR:

Attached hereto for filing are the following papers:

NOTICE OF APPEAL (IN DUPLICATE)
37 CFR 1.192 APPEAL BRIEF (IN TRIPLICATE)
ATTACHMENT 1 (IN TRIPLICATE)
AMENDMENT COVER LETTER AND AUTHORIZATION TO CHARGE DEPOSIT
ACCOUNT (IN DUPLICATE)
37 CFR 1.111 AMENDMENT

Our check in the amount of \$660.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106

31518

PATENT TRADEMARK OFFICE

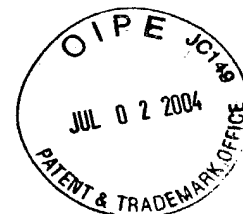
7/2/04
Date

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Printed: July 2, 2004

(10:12am)Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\TransLtr_040630.wp
d

Docket No. CAT/34-SCRO-CCP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Michael C. SCROGGIE et al.

GAU: 3623

SERIAL NO: 09/505,632

EXAMINER ROBINSON-BOYCE

FILED: February 16, 2000

FOR: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION THROUGH COOPERATIVE COMMUNICATION NETWORK SITES

NOTICE OF APPEAL

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicants hereby appeal to the Board of Appeals from the final office action dated _____ and further in view of the amendment after final filed on _____.

The items checked below are appropriate:

☐ A Petition for Extension of Time Under 37 C.F.R. §1.136 was filed for _____ months.

☐ A timely response to the final rejection was filed on _____, as provided in 841 O.G. 1411.

☐ An Appeal Brief being filed herewith.

☐ A Petition for Extension of Time for filing the Notice of Appeal is attached.

☐ Applicant claims small entity status. See 37 C.F.R. §1.27.

☒ 37 C.F.R. §1.17(b) Notice of Appeal fee is enclosed.

☒ 37 C.F.R. §1.17(c) Appeal Brief fee is enclosed.

Total Appeal fees enclosed: \$660.00.

☒ Please charge any additional fees or credit any overpayment of fees required for filing the Notice of Appeal to Deposit Account No. 50-2106. A duplicate copy of this Notice is enclosed.

☒ If this notice is not considered timely filed by the U.S. Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 50-2106. A duplicate copy of this Notice is enclosed.

07/06/2004 SDIRETA1 00000149 09505632

01 FC:1401

330.00 GP



31518

PATENT TRADEMARK OFFICE

Neifeld IP Law, PC
Crystal Plaza I
2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

Date

7/2/04

Respectfully Submitted,

Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

Tel: 703-415-0012

Fax: 703-415-0013

Email: rneifeld@Neifeld.com

RECEIVED

JUL 07 2004

Technology Center 2100

RECEIVED

JUL 14 2004

GROUP 3600

Printed: June 30, 2004 (12:28pm)

Y:\Clients\Catalina\CAT29-SCRO\CAT29SCROCO2CP\Drafts\NOA_040630.wpd

NEIFELD DOCKET NO: CAT/34-SCRO-CCP

PRIOR ATTORNEY DOCKET NO: 7791-0103-25XCONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 5917

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/505,632

FILING DATE: February 16, 2000

GROUP ART UNIT: 3623

EXAMINER: ROBINSON-BOYCE, A.

TITLE: System and Method for Distributing Information Through Cooperative Communication
Network Sites

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

RECEIVED

JUL 07 2004

Technology Center 2100

37 CFR 1.192 APPEAL BRIEF

Sir:

In response to the final office action mailed April 6, 2004, the applicants appeal.

RECEIVED

JUL 14 2004

GROUP 3600

07/06/2004 82IRETA1 00000149 09505632

02 FC:1402

330.00 0P

TABLE OF CONTENTS

| | | |
|------|--|---|
| I. | 37 CFR 1.192(a) | 1 |
| II. | 37 CFR 1.192(b) | 1 |
| III. | 37 CFR 1.192(c) | 1 |
| A. | 37 CFR 1.192(c)(1) Real Party in Interest | 1 |
| B. | 37 CFR 1.192(c)(2) Related Appeals and Interferences | 1 |
| C. | 37 CFR 1.192(c)(3) Status of Claims | 1 |
| D. | 37 CFR 1.192(c)(4) Status of Amendments | 1 |
| E. | 37 CFR 1.192(c)(5) Summary of the Invention | 1 |
| F. | 37 CFR 1.192(c)(6) Issues | 3 |
| G. | 37 CFR 1.192(c)(7) Grouping of Claims | 3 |
| H. | 37 CFR 1.192(c)(8) Argument | 4 |
| 1. | 37 CFR 1.192(c)(8)(ii) - Second Paragraph 35 USC 112 | 4 |
| a. | The Rejections Under 35 USC 112 of Claims 50 and 51 | 4 |
| 1. | The Examiner's Argument | 4 |
| 2. | The Applicants' Response | 4 |
| 2. | 37 CFR 1.192(c)(8)(iii) - 35 USC 102 | 6 |
| a. | The Rejections Under 35 USC 102(e) of Claims 28 and 40 as Being Anticipated by Sloane | 6 |
| 1. | The Examiner's Argument | 6 |
| 2. | The Board of Patent Appeals and Interferences Reversed the Rejections Under 35 USC 102(e) of Claims 28 and 40 as Being Anticipated by Sloane, so the Repeated Rejection of these Claims is Barred by 37 CFR 1.197(a) | 7 |
| 3. | The Rejections Under 35 USC 102(e) of Claims 50 and 51 as Being Anticipated by Sloane | 9 |
| (a) | The Examiner's Argument | 9 |

| | | |
|-----|---|----|
| (b) | The Rejections Under 35 USC 102(e) of Claims 50 and 51 as Being Anticipated by Sloane are Barred by Issue Preclusion | 10 |
| (c) | In any Case, Sloane does not Anticipate Claims 50 and 51 | 12 |
| 3. | 37 CFR 1.192(c)(8)(iv) - Rejections Under 35 USC 103(a) | 13 |
| a. | The Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloane and Further in View of Hoffman | 13 |
| 1. | The Examiner's Argument | 13 |
| 2. | The Applicants' Response | 15 |
| (a) | The Board of Patent Appeals Reversed the Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloan and Further in View of Hoffman | 15 |
| (b) | The Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloan and Further in View of Hoffman are Untenable and Should be Reversed | 16 |
| i. | Hoffman is not Prior Art | 16 |
| ii. | The Claims Distinguish, in any Case | 17 |
| b. | The Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloane and Further in View of Hoffman and Smolen | 21 |
| 1. | The Examiner's Argument | 21 |
| 2. | The Applicants' Response | 22 |
| (a) | The Board of Patent Appeals Reversed the Rejections Under 35 USC 103(a) of Claims 26, | |

| | | |
|-----|---|----|
| | 30, 31, 38, 42, and 43 as Being Obvious Over Sloan and Further in View of Hoffman and Smolen | 22 |
| (b) | The Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloan and Further in View of Hoffman and Smolen are Untenable and Should be Reversed .. | 22 |
| 4. | 37 CFR 1.192(c)(8)(v) - Other Rejections Under 35 USC 103(a) | 24 |
| a. | Objections to Claims 50 and 51 | 24 |
| 1. | The Examiner's Argument | 24 |
| 2. | The Applicants' Response | 25 |
| IV. | Groupings of Claims - Why Rejections of Each Group Should be Reversed | 25 |
| A. | Group 1 - Claims 28 and 40 | 25 |
| B. | Group 3 - Claims 24, 36, 48, and 49 | 25 |
| C. | Group 5 - Claims 25 and 37 | 26 |
| D. | Group 6 - Claims 27 and 39 | 26 |
| E. | Group 7 - Claims 29 and 41 | 26 |
| F. | Group 8 - Claims 26 and 38 | 26 |
| G. | Group 9 - Claims 30 and 42 | 27 |
| H. | Group 10 - Claims 31 and 43 | 27 |
| I. | Group 11 - Claims 50 and 51 | 27 |
| V. | 37 CFR 1.192(d) - Non-compliant Brief | 27 |
| VI. | Appendix - Claims 24-51 Involved in the Appeal | 29 |

I. 37 CFR 1.192(a)

This brief is filed in triplicate, is accompanied by the fee set forth in 37 CFR 1.17(c), and sets forth the authorities and arguments on which the applicants will rely to maintain the appeal.

II. 37 CFR 1.192(b)

The filing is timely. Accordingly, this subsection is not relevant.

III. 37 CFR 1.192(c)

A. 37 CFR 1.192(c)(1) Real Party in Interest

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B. 37 CFR 1.192(c)(2) Related Appeals and Interferences

An appeal is pending in the following related application:

US Application No: 08/873,974, filed June 12, 1997 (Neifeld Ref: CAT/34-SCRO-US). The applicants filed an appeal brief December 23, 2002. The examiner's answer to the appeal brief filed December 23, 2002 was mailed March 11, 2003. The applicants filed a reply brief April 22, 2003. The Board of Patent Appeals and Interferences assigned Appeal No: 2004-1267 on April 5, 2004.

C. 37 CFR 1.192(c)(3) Status of Claims

Claims 24-31, 36-43 and 48-51 are pending, rejected, and under appeal. Claims 32-35 and 44-47 have been canceled.

D. 37 CFR 1.192(c)(4) Status of Amendments

An amendment to claims 50 and 51 correcting only a grammatical error has not been entered, and is being filed with this brief.

E. 37 CFR 1.192(c)(5) Summary of the Invention

The present invention is directed to a computer network implemented method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site of the manufacturer over the Internet to a remote Web site; in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one

manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address. See Claims 24, 36 and 48.

The method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site further includes transmitting a link to a Web site of the retailer. See Claims 25 and 37.

The method and system as defined in Claims 24 and 36, further includes the step of determining the at least one manufacturer's incentive and the at least one name and address of a retailer by querying, using the region data, a database from a server of the remote Web site. See Claims 26 and 38.

The method and system as defined in Claims 24 and 36, further includes the steps of transmitting from the consumer computer to the Web site of the manufacturer selection data indicating selection of the at least one manufacturer incentive; transmitting from the Web site of the manufacturer to the remote site the selection data; transmitting from the remote site to the Web site of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to the consumer computer the details. See Claims 27 and 39.

The present invention is further directed to a computer network implemented method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer; in response to receipt of the request at the Web site of the retailer, transmitting the request from the Web site of the retailer over the Internet to a remote Web site; in response to receipt of the request at the remote site, transmitting from the remote site over the Internet to the Web site of the retailer a list of manufacturer incentives; and in response to receipt of the manufacturers incentives at the Web site of the retailer, transmitting over the Internet to the consumer computer the list of manufacturers incentives. See Claims 28, 40 and 49.

The method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from the Web site of the retailer over the Internet to the remote Web site in association with the request; and determining manufacturer's incentives to transmit

from the remote Web site to the Web site of the retailer based upon the user identification. See Claims 29 and 41.

The method and system as defined in Claims 28 and 40, further includes the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data. See Claims 30 and 42.

The method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See Claims 31 and 43.

The invention of claims 50 and 51 are a system and a method for performing transactions involving multiple separate entities, including means for transmitting a list of manufacturer incentives from: the consumer to a retailer website, the retailer website to a remote website, and the remote website to the retailer website (page 3 line 27 through page 4 line 5).

In contrast, conventional systems and methods do not disclose nor suggest the abovenoted features of the claimed invention. In view of problems inherent with conventional systems and methods, the applicants have discovered an improved computer network implemented method, system, and computer program product, as described above.

F. 37 CFR 1.192(c)(6) Issues

Whether the rejections of claims 50 and 51 under the second paragraph of 35 USC 112 are improper and should be reversed.

Whether the rejections of claims 28, 40, 50, and 51 under 35 USC 102(e) based upon Sloane (US Patent 5,918,211) [hereinafter "Sloane"] are improper and should be reversed.

Whether the rejections of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 under 35 USC 103(a) based upon Sloane and further in view of Hoffman et al. (US Patent 6,012, 039) [hereinafter "Hoffman"] are improper and should be reversed.

Whether the rejections of claims 26, 30, 31, 38, 42, and 43 under 35 USC 103(a) based upon Sloane, Hoffman, and Smolen (US Patent 5,915,243) [hereinafter "Smolen"] are improper and should be reversed.

G. 37 CFR 1.192(c)(7) Grouping of Claims

Group 1 consists of claims 28 and 40. Group 3 consists of claims 24, 36, 48, and 49. Group 5 consists of claims 25 and 37. Group 6 consists of claims 27 and 39. Group 7 consists

of claims 29 and 41. Group 8 consists of claims 26 and 38. Group 9 consists of claims 30 and 42. Group 10 consists of claims 31 and 43. Group 11 consists of claims 50 and 51.

H. 37 CFR 1.192(c)(8) Argument

1. 37 CFR 1.192(c)(8)(ii) - Second Paragraph 35 USC 112

a. The Rejections Under 35 USC 112 of Claims 50 and 51

1. The Examiner's Argument

In support of the rejections of claims 50 and 51 under 35 USC 112, second paragraph, the examiner stated that:

Claims 50 and 51 recites [sic] the limitation "transmission from the a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "mean for transmitting from the a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required. [Office action mailed April 6, 2004 page 2 lines 18-24.]

2. The Applicants' Response

In reply, the applicants disagree for several reasons.

First, there is almost ipsus verbis antecedent basis support for the subject claim recitations in the specification, and the subject claim recitations are clearly supported by the specification's recitations. See page 3 lines 23-26 and page 11 lines 1-4.

Page 3 lines 23-26 of the specification states that:

The next steps of the method are receiving offer selection data from the consumer through the manufacturer network site, and either transmitting details of the selected offers to the manufacturer network site for use by the consumer, or linking the consumer directly to a selected retailer network site to view the available offers.

Page 11 lines 1-4 of the specification states that:

FIG. 5 shows how manufacturers input update data to the manufacturer offer database 16. In one approach, the manufacturer supplies the data on input

forms 90, which are entered at the SMO site 14, as indicated at 92, and transmitted to the databases 16 and 20 by means of an update program 94 executed at the SMO site.

These two recitations clearly disclose that there is a transmission (and a means for transmission) from the retailer website to a remote website; and a transmission (and a means for transmission) from the retailer website to a remote website. Moreover, there is sufficient indication as to what is being transmitted, namely, details of the selected offers, as well as data that is input by manufacturers and used to update the manufacturer offer database.

Second, in drafting claims 50 and 51, the applicant presented a method claim and a system claim commensurate in scope with and mirroring the wording in the Board of Patent Appeals and Interferences' (panel's) description of the independent claimed inventions. In the decision on appeal mailed October 27, 2003, the panel stated that:

With regard to the rejections under 35 U.S.C. 103, we will not sustain these rejections because each of the independent claims 24, 36, 48, and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from the a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer web site transmits to the consumer a list of these incentives.

[Decision on appeal page 9 lines 3-10.]

Since claims 50 and 51 are essentially identical in scope to the panel's description of applicant's claimed invention, they are allowable for the same reasons applying to appealed claims 24-31, 36-43, and 48-49.¹

Third, the examiner's rejections for lack of antecedent basis misapplies the law because anyone reading the claims would know what they defined. The applicants submit herewith an amendment correcting the grammatical error in these claims, mooted the antecedent basis issue.

¹ A copy of the decision on appeal mailed October 27, 2003 is Attachment 1.

For all of the foregoing reasons, the rejections of claims 50 and 51 as indefinite are improper and therefore should be reversed.

2. **37 CFR 1.192(c)(8)(iii) - 35 USC 102**

a. **The Rejections Under 35 USC 102(e) of Claims 28 and 40 as Being Anticipated by Sloane**

1. **The Examiner's Argument**

In support of the rejections under 35 USC 102(e) of claims 28 and 40 as being anticipated by Sloane, the examiner stated that:

Claims 28, 40, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 40, Sloane discloses:

transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 7, lines 13-22);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said

consumer computer said list of manufacturers incentives, (Col. 8, lines 3-7).

[Office action mailed April 6, 2004 page 3 line 12 through page 4 line 11.]

**2. The Board of Patent Appeals and Interferences
Reversed the Rejections Under 35 USC 102(e) of Claims
28 and 40 as Being Anticipated by Sloane, so the
Repeated Rejection of these Claims is Barred by 37
CFR 1.197(a)**

In the decision on appeal mailed October 27, 2003, the panel reversed the examiner's rejections under 35 USC 102(e) of Claims 28, 40 as being anticipated by Sloane. In its opinion, the panel stated that:

Turning, initially, to the rejection under 35 U.S.C. § 102(e), an anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990) .

It is the examiner's position that Sloane discloses, at column 7, lines 5-10, the transmission from a consumer computer of a request for manufacturer incentives; at column 7, lines 13-22, the transmission of region data from the website of a manufacturer in response to the request for- manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacture incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer

computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e). [Decision on appeal page 3 line 15 through page 6 line 11.] 37 CFR 1.197(a) entitled "Action following decision," states that:

After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal

or other review, for such further action by appellant or by the examiner, as the condition of the application may require, **to carry into effect the decision.**

[Emphasis supplied.]

In conformity with this panel's holding, the examiner's rejections of claims 28 and 40 as being anticipated by Sloane are improper, as they are precluded by 37 CFR 1.197(a) and res judicata. Therefore, the examiner should reverse the rejections of claims 28 and 40.

3. The Rejections Under 35 USC 102(e) of Claims 50 and 51 as Being Anticipated by Sloane

(a) The Examiner's Argument

In support of the rejections of claims 50 and 51 under 35 USC 102(e) as being anticipated by Sloane, the examiner stated that:

Claims [50 and 51] are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211). [Office action page 3 lines 12-13.]

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

Transmission from the retailer website to a remote website, (Col. 7, lines 13-22), and

Transmission from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website [sic], (Col. 7, lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col. 7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26). [Office action page 4 lines 12-25.]

**(b) The Rejections Under 35 USC 102(e) of Claims
50 and 51 as Being Anticipated by Sloane are
Barred by Issue Preclusion**

In its simplest construct, res judicata precludes the relitigation of a claim, or cause of action, or any possible defense to the cause of action which is ended by a judgment of the court. See Restatement (Second) of Judgments, § § 18, 19 (1982). This aspect of res judicata, known in modern parlance as "claim preclusion", applies whether the judgment of the court is rendered after trial and imposed by the court or the judgment is entered upon the consent of the parties. See, e.g., *Lawlor v. National Screen Serv. Corp.*, 349 U.S. 322, 327 (1955); *Kaspar Wire Works, Inc. v. Leco Eng'g and Mach., Inc.*, 575 F.2d 530, 538-39, 198 USPQ 513, 518-19 (5th Cir. 1978); 18 C. Wright, A. Miller, and E. Cooper, *Federal Practice and Procedure*, § 4443 at 385 (1981) (consent judgments ordinarily support claim preclusion but not issue preclusion). [*Foster v. Hallco Manufacturing Co. Inc.*, ___ F.3d ___, ___, 20 USPQ2d 1241, 1246 (Fed. Cir. 1991).]

Section 27 of the Restatement states the general rule of issue preclusion:

When an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.

Restatement (Second) of Judgments, § 27. A rationale for the rule of issue preclusion is that once a legal or factual issue has been settled by the court after a trial in which it was fully and fairly litigated that issue should enjoy repose. See *Southern Pacific R.R.*, 168 U.S. at 48-49. Such litigated issues may not be relitigated even in an action on a different claim between the parties. See Restatement (Second) of Judgments, § 27 comment (e) & note at 267-68; *Young Eng'rs*, 721 F.2d at 1316, 219 USPQ at 1152; *Jackson Jordan*, 747 F.2d at 1575-76, 224 USPQ at 7; *Eilrich v. Ramas*, 839 F.2d 630, 632 (9th Cir. 1988); *Garrett v. City and County of San Francisco*, 818 F.2d 1515, 1520 (9th Cir. 1987). Where a judgment between parties is entered by consent prior to trial on any issue, no issue may be said to have been fully, fairly or actually litigated. See Restatement, § 27 comment (e) at 257; *Kaspar Wire Works*, 575 F.2d at 537, 198 USPQ at 518. Thus, the general rule that issue preclusion does not arise from a consent

judgment would allow Foster's challenge to validity on a different claim inasmuch as no issue was actually tried and disposed of by decision of the court in Foster I. [Foster v. Hallico Manufacturing Co. Inc., ___ F.3d ___, ___, 20 USPQ2d 1241, 1250-51 (Fed. Cir. 1991).]

Based on the reversal of the rejections under 35 USC 103 of independent claims 24, 36, 48, and 49 as being obvious over Sloane in the decision on appeal mailed October 27, 2003, the applicants added claims 50 and 51, which are commensurate in scope with and mirror the wording in the panel's description of the independent claimed inventions.

Specifically, in reversing the rejections of claims 24, 36, 48, and 49, the panel stated that:

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. **As explained supra, Sloane is devoid of any such teaching.** Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. 103. [Decision on appeal page 9 lines 3-18; emphasis supplied.]

Since claims 50 and 51 are essentially identical in scope to the panel's description of applicants' claimed invention, they raise the issue decided in the appeal, and they are allowable over the art cited by the examiner for the same reasons applying to the appealed claims. The issue being whether Sloane discloses claims 50 and 51's consumer website, retailer website, and remote website transmissions. Therefore, no new issues were raised with the addition of claims 50 and 51; and therefore, the examiner's assertion that claims 50 and 51 are anticipated by Sloane is barred by issue preclusion.

Accordingly, the rejections under 35 USC 102(e) of claims 50 and 51 as being anticipated by Sloane are improper and therefore should be reversed for issue preclusion.

**(c) In any Case, Sloane does not Anticipate Claims
50 and 51**

The examiner asserts that claims 50 and 51 are rejected under 35 USC 102(e) as being anticipated by Sloane, stating that:

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

Transmission from the retailer website to a remote website, (Col. 7, lines 13-22), and

Transmission from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website, (Col. 7, lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col. 7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26). [Office action page 4 lines 12-25.]

In reply, the applicants submit that the examiner's assertion is incorrect. Sloane fails to disclose what is recited in claims 50 and 51.

Sloane column 7 lines 5-10 does not disclose a retailer website and it does not disclose transmission between a consumer and a retailer website. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 13-22 does not disclose either a remote website or a retailer website and it does not disclose transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 22-26 does not disclose either a remote website or a retailer website and it does not disclose transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 5-10 does not disclose a retailer website and it does not disclose means for transmission between a consumer and a retailer website. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 13-22 does not disclose either a retailer website or a remote website and it does not disclose means for transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 22-26 does not disclose either a remote website or a retailer website and it does not disclose means for transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

3. 37 CFR 1.192(c)(8)(iv) - Rejections Under 35 USC 103(a)

a. The Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloane and Further in View of Hoffman

1. The Examiner's Argument

In support of the rejections under 35 USC 103(a) of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as being obvious over Sloane and further in view of Hoffman, the examiner stated that:

Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:
transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting ... in response to said request for manufacturer incentives, transmitting region data ... means for, in response to said request ... in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data ... (Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:
transmitting ... at least one name.../means for transmitting ... at least one

name ... (Col. 11, lines 1-9 read with Col. 13, lines 5-10).

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Hoffman, et al discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link ... /wherein said means for transmitting from said remote site said list further comprises means for transmitting a link ... (Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting ... (Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Hoffinan, et al discloses: transmitting from said Web site of said manufacturer.../means for transmitting from said Web site ... (Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details...lmeans for transmitting from said remote site ... (Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer ... (Col. 6, lines 62-63).

It would have been obvious to one of ordinary skill In the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

transmitting a user identification .../means for transmitting a user identification ... determining manufacturer's incentives ...means for determining manufacturer's incentives ... (Col. 9, lines 52-58, Claim 12, Claim 15). [Office action mailed April 6, 2004 page 5 line 11 through page 7 line 11.]

2. **The Applicants' Response**

(a) **The Board of Patent Appeals Reversed the Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloan and Further in View of Hoffman**

In its opinion, the panel addressed the rejections under 35 USC 103(a) of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as being obvious over Sloane and further in view of Hoffman and stated that:

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, **Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. 103.** [Decision on appeal page 9 lines 3-18; emphasis supplied.]

Based on the Board's authority enumerated in 37 CFR 1.197(a), cited infra, the rejections under 35 USC 103(a) of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as being obvious over

Sloane and further in view of Hoffman are improper, as they are precluded by 37 CFR 1.197(a), claim preclusion, and res judicata, and therefore should be reversed.

(b) **The Rejections Under 35 USC 103(a) of Claims
24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being
Obvious Over Sloan and Further in View of
Hoffman are Untenable and Should be Reversed**

Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Hoffman. That rejection is untenable and should be reversed.

i. **Hoffman is not Prior Art**

In reply, the applicant submits, first of all, that Hoffman is NOT 102(e) prior art. Hoffman is USP 6,012,039 to Hoffman, which issued from application 09/244,784 filed 2/5/1999.

This application has a U.S. 35 USC 120 priority filing date of 6/12/1997 via priority claim to application 08/873,974.

Accordingly, USP 6,012,039 to Hoffman is not prima facie prior art.

Moreover, Hoffman's disclosure upon which the examiner relies does not exist in its claimed priority application. Hoffman claims priority (as an alleged "continuation" from application 08/705,399 filed: 8/29/1966. 08/705,399 issued as USP 5,870,723. However, **the disclosure in Hoffman relied upon by the examiner does not exist in USP 5,870,723.** Specifically, the examiner relies upon column 11 lines 1-9 in Hoffman, which read as follows:

In a preferred embodiment, the transaction processor 26 receives the identification results from the identification module. Once the recipient and their rewards accounts, as well as the particular rule module that would govern this transaction is located, using the identity of the recipient, the transaction processor locates the recipient's Recipient Electronic Registry (RER). Using the issuer identification data (Issuer ID 64) contained in the transaction request message 60, the transaction processor identifies the issuer's default rule module 62 which contains the instructions for debit or credit of the recipients rewards account. Alternatively, the instruction for debit and credit and various other restrictions on

credit or debit of a recipient's reward account is contained in the transaction request message itself 60. Should the transaction request message 60 contain an electronic pointer 68, the default rule module is then overridden and another rule module (rule module P1, P2, etc.) particular to the reward transaction is invoked.

That passage does not exist in USP 5,870,723.

The examiner also relies upon column 13 lines 5-10 in Hoffman. This passage reads:

Typically, a rewards issuer registers issuer identification data (Issuer ID) with the electronic identifier. The Issuer ID comprises any of the following: digital certificate, hardware identification, web site, trade name, financial account number, telephone number, employer identification number, and the like.

That passage does not exist in USP 5,870,723.

In summary, there is no evidence to support the conclusion that the disclosure in Hoffman at column 11 lines 1-9 or column 13 lines 5-10 is prior art. In fact, the applicant has just shown that evidence of record (USP 5,870,723 was made of record prior to the appeal and its lack of prior art status was argued in the prior brief; the Board's failure to recognize that argument constitutes facts overlooked) and conclusively proved that **Hoffman is not prior art**. For this additional reason, the rejections are substantively improper.

ii. **The Claims Distinguish, in any Case**

Nonetheless, the applicants submit that the claimed invention, as recited in Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49, is patentably distinguishable over Sloane, alone or in combination with Hoffman, as is further argued below.

The present invention, as recited in Claims 24, 36, 48, and 49, is directed to the method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site 10 of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site 10 of the manufacturer over the Internet to a remote Web site 14; in response to receipt of region data at the manufacturer's Web site 10, transmitting from the remote Web site 14 to the Web site 10 of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site 10 of the manufacturer over the Internet to the consumer computer the at least

one manufacturer incentive and the at least one name and address. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest all of the noted features of the claimed invention.

The examiner asserts at page 5 line 14 through page 6 line 16 of the office action mailed April 6, 2004 that Sloane teaches all of the above-noted features except "in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address." However, the applicants submit that although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200, as previously described, Sloane fails to disclose or suggest the noted features of the claimed invention. See Figures 3a and 3b and the discussion in Sloane thereof. The applicants submit that Hoffman fails to cure the noted deficiencies with Sloane and that Claims 24, 36, 48, and 49 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman.

Further, as acknowledged by the examiner at page 5 lines 23-24 of the office action mailed April 6, 2004, Sloane fails to teach or suggest "transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer, and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address." The examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 11, lines 1-9 and column 13, lines 5-10 of Hoffman.

However, the applicants submit that Hoffman merely discloses a secure incentive distribution system and method between a party identification apparatus (PIA) 1 and a data processing center (DPC) 22 via a communications network 10, such as the Internet and fail to teach or suggest the noted feature of the claimed invention. See Figs. 1 and 2, and column 6, line 28 to column 8, line 41 of Hoffman.

In the above respect, the applicants submit that in the invention of Hoffman there is no need to send a name and address of a retailer since Hoffman teaches that the identification of

both parties during an incentives distribution transaction are automatically identified by decrypting provided encryption codes. See column 8, lines 42-52 of Hoffman. Accordingly, the applicants submit that, contrary to the assertion by the examiner, Hoffman fails to teach or suggest the noted feature of the claimed invention and that Claims 24, 36, and 48 are not obvious under 35 U.S.C. § 103(a) over, Sloane, alone or in combination with Hoffman.

The present invention, as recited in Claims 25 and 37, is directed to the method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site 14 further includes transmitting a link to a Web site 12 of the retailer. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 6, lines 7-10 of the office action mailed April 6, 2004, Sloane fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 14, lines 64-67 of Hoffman.

However, the applicants submit that Hoffman merely discloses a reward recipient locating a Web site of a rewards issuer, but fails to teach or suggest transmitting from a **remote site** a link to a Web site of a retailer, as in the claimed invention (emphasis added). See column 14, lines 64-67 of Hoffman. Accordingly, the applicants submit that Claims 25 and 37 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman.

The present invention, as recited in Claims 27 and 39, is directed to the method and system as defined in Claims 24 and 36, further includes the steps of transmitting from a consumer computer to a Web site 10 of a manufacturer selection data indicating selection of at least one manufacturer incentive; transmitting from the Web site 10 of the manufacturer to a remote site 14 the selection data; transmitting from the remote site 14 to the Web site 10 of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site 10 of the manufacturer to the consumer computer the details. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention.

The applicants submit that, contrary to the assertion by the examiner at page 6 lines 14-16 of the office action mailed April 6, 2004, although Sloane discloses processing incentives

between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200 as previously discussed, Sloane fails to disclose or suggest transmitting from a consumer computer to a Web site of a manufacturer selection data indicating selection of at least one manufacturer incentive, as in the claimed invention. The applicants submit that Hoffman fails to cure the noted deficiencies with Sloane and that Claims 27 and 39 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman.

In addition, as acknowledged by the examiner, at page 6, lines 7-14 of the office action mailed April 6, 2004, Sloane fails to teach or suggest transmitting from a Web site of the manufacturer to a remote site selection data; transmitting from the remote site to the Web site of the manufacturer details of selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to a consumer computer the details, as in the claimed invention. The examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 6, lines 46-63 of Hoffman.

However, the applicants submit that Hoffman merely discloses a personal identification apparatus (PIA) 1 capable of performing various secure reward processing functions with a data processing device (DPC) 22, but fails to teach or suggest the noted features of the claimed invention. See column 6, lines 27-65 of Hoffman. Accordingly, the applicants submit that Claims 27 and 39 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman.

The present invention, as recited in Claims 29 and 41, is directed to the method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from a Web site 12 of a retailer over the Internet to a remote Web site 14 in association with a request; and determining manufacturer's incentives to transmit from the remote Web site 14 to the Web site 12 of the retailer based upon the user identification. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention.

The applicants submit that, contrary to the assertion by the examiner at page 7, lines 7-11 of the office action mailed April 6, 2004, although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200 as previously discussed, Sloane fails to disclose or suggest the noted features of the claimed invention. The applicants submit that Hoffman fails to cure the

noted deficiencies with Sloane and that Claims 29 and 41 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman.

Based on the above discussion, the applicants submit that claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 are patentably distinguishable under 35 USC 103 over the applied references and therefore should be reversed.

b. The Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloane and Further in View of Hoffman and Smolen

1. The Examiner's Argument

In support of the rejections under 35 USC 103(a) of claims 26, 30, 31, 38, 42, and 43 based upon Sloane and further in view of Hoffman and Smolen, the examiner stated that:

Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen. discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining..
.transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting ... (Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

wherein said region data is postal code data ... (Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It, would have been obvious to one of ordinary skill in the art for the

region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer. [Office action mailed April 6, 2004 page 7 line 12 through page 8 line 12.]

2. The Applicants' Response

(a) The Board of Patent Appeals Reversed the Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloan and Further in View of Hoffman and Smolen

Based on the arguments contained in III. H. 3. a. 2., *infra*, the rejections under 35 USC 103(a) of claims 26, 30, 31, 38, 42, and 43 based upon Sloane and further in view of Hoffman and Smolen are improper, as they are precluded by 37 CFR 1.197(a), claim preclusion, *res judicata*, and therefore should be reversed.

Based on the arguments regarding Hoffman contained in III. H. 3. a. 2. b. i., *infra*, there is no *prima facie* case for the rejections under 35 USC 103(a) of claims 26, 30, 31, 38, 42, and 43 as being obvious over Sloan and further in view of Hoffman and Smolen because Hoffman is not prior art.

(b) The Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloan and Further in View of Hoffman and Smolen are Untenable and Should be Reversed

Claims 26, 30, 31, 38, 42, and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Hoffman and further in view of Smolen. In any case, the rejections are untenable, and should be reversed for the following reason.

The present invention, as recited in Claims 26 and 38, is directed to the method and system as defined in Claims 24 and 36, further includes the step of determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database 16 from a server 14 of a remote Web site. See, e.g., Figs. 1 and 2 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in

combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 7, lines 15-21 of the office action mailed April 6, 2004, Sloane, in combination with Hoffman, fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloane and Hoffman by applying disclosure from column 2, line 66 to column 3, line 9 of Sloan.

However, the applicants submit that Smolen merely discloses providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection, but fails to teach or suggest determining at least one manufacturer's incentive and at least one **name and address of a retailer** by querying, using region data, a database from a server of a remote Web site, as in the claimed invention (emphasis added). See column 2, line 66 to column 3, line 9 and column 7, lines 12-24 of Smolen. Accordingly, the applicants submit that Claims 26 and 38 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman and further in view of Smolen.

The present invention, as recited in Claims 30 and 42, is directed to the method and system as defined in Claims 28 and 40, further includes the step of transmitting from a consumer computer over the Internet to a Web site 12 of a retailer region data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 7 lines 15-21 of the office action mailed April 6, 2004, Sloane, in combination with Hoffman, fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloan and Hoffman by applying disclosure from column 2, line 66 to column 3, line 9 of Smolen

However, the applicants submit that Smolen merely discloses providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection and generating a user profile including demographic information, such a phone number of the consumer, but fails to teach or suggest the noted feature of the claimed invention. See column 2, line 66 to column 3, line 9, column 4, lines 55-67 and column 7, lines 12-24 of Smolen. Accordingly, the applicants submit that Claims 30 and 42 are

not obvious under 35 U.S.C. § 103(a) over Sloane in view of Hoffman and further in view of Smolen.

The present invention, as recited in Claims 31 and 43, is directed to the method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 8, lines 5-9 of the office action mailed April 6, 2004, Sloane, in combination with Hoffman, fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloan and Hoffman by applying disclosure from column 4, line 64-67 of Smolen.

However, the applicants submit that Smolen merely discloses providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection and generating a user profile including demographic information, such a phone number of the consumer, but fails to teach or suggest the noted feature of the claimed invention. See column 2, line 66 to column 3, line 9, column 4, lines 55-67 and column 7, lines 12-24 of Smolen. Accordingly, the applicants submit that Claims 31 and 43 are not obvious under 35 U.S.C. § 103(a) over Sloane in view of Hoffman and further in view of Smolen

Based on the above discussion, the applicants submit that claims 26, 30, 31, 38, 42, and 43 are patentably distinguishable under 35 USC 103 over the applied references and therefore should be reversed.

4. 37 CFR 1.192(c)(8)(v) - Other Rejections Under 35 USC 103(a)

a. Objections to Claims 50 and 51

1. The Examiner's Argument

In objecting to the informalities in claims 50 and 51, the examiner stated that:

Claims 50 and 51 are objected to because of the following informalities: in the 3rd line of both claims, after "from the", the letter "a" is included and should be omitted for grammatical purposes. Appropriate correction is required.

[Office action mailed April 6, 2004 page 2 lines 11-13.]

2. The Applicants' Response

In reply, the applicants submit herewith an amendment to claim 50 changing "the a consumer" to "the consumer", and to claim 51 changing "the a consumer" to "the consumer".

IV. Groupings of Claims - Why Rejections of Each Group Should be Reversed

A. Group 1 - Claims 28 and 40

The present invention, as recited in Claims 28 and 40, is directed to a computer network implemented method and system including transmitting from a consumer computer over the Internet to a Web site 12 of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer; in response to receipt of the request at the Web site 12 of the retailer, transmitting the request from the Web site 12 of the retailer over the Internet to a remote Web site 14; in response to receipt of the request at the remote site 14, transmitting from the remote site 14 over the Internet to the Web site 12 of the retailer a list of manufacturer incentives; and in response to receipt of the manufacturers incentives at the Web site 12 of the retailer, transmitting over the Internet to the consumer computer the list of manufacturers incentives. The applicants submit that Sloane fails to disclose or suggest the above-noted features of the claimed invention.

B. Group 3 - Claims 24, 36, 48, and 49

The present invention, as recited in Claims 24, 36, 48, and 49, is directed to the method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site 10 of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site 10 of the manufacturer over the Internet to a remote Web site 14; in response to receipt of region data at the manufacturer's Web site 10, transmitting from the remote Web site 14 to the Web site 10 of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site 10 of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address. The applicants submit that Sloane, alone or in combination with Hoffman et al, fails to disclose or suggest all of the noted features of the claimed invention. In addition, Hoffman is not prior art.

C. Group 5 - Claims 25 and 37

The present invention, as recited in Claims 25 and 37, is directed to the method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site 14 further includes transmitting a link to a Web site 12 of the retailer. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

D. Group 6 - Claims 27 and 39

The present invention, as recited in Claims 27 and 39, is directed to the method and system as defined in Claims 24 and 36, further includes the steps of transmitting from a consumer computer to a Web site 10 of a manufacturer selection data indicating selection of at least one manufacturer incentive; transmitting from the Web site 10 of the manufacturer to a remote site 14 the selection data; transmitting from the remote site 14 to the Web site 10 of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site 10 of the manufacturer to the consumer computer the details. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

E. Group 7 - Claims 29 and 41

The present invention, as recited in Claims 29 and 41, is directed to the method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from a Web site 12 of a retailer over the Internet to a remote Web site 14 in association with a request; and determining manufacturer's incentives to transmit from the remote Web site 14 to the Web site 12 of the retailer based upon the user identification. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

F. Group 8 - Claims 26 and 38

The present invention, as recited in Claims 26 and 38, is directed to the method and system as defined in Claims 24 and 36, further includes the step of determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database 16 from a server 14 of a remote Web site. See, e.g., Figs. 1 and 2 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in

combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

G. Group 9 - Claims 30 and 42

The present invention, as recited in Claims 30 and 42, is directed to the method and system as defined in Claims 28 and 40, further includes the step of transmitting from a consumer computer over the Internet to a Web site 12 of a retailer region data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

H. Group 10 - Claims 31 and 43

The present invention, as recited in Claims 31 and 43, is directed to the method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

I. Group 11 - Claims 50 and 51

The rejections of claims 50 and 51 should be reversed because the examiner has not shown that Sloane discloses a system or method including transmission from the consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives.

V. 37 CFR 1.192(d) - Non-compliant Brief

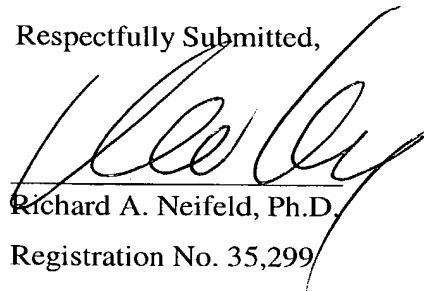
This brief is in compliance with 37 CFR 1.192(c). Accordingly, this subsection is inapplicable.

31518

PATENT TRADEMARK OFFICE

7/2/04
Date

Respectfully Submitted,


Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

Printed: July 2, 2004 (10:51am)

Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\AppealBrief040525.wpd

VI. Appendix - Claims 24-51 Involved in the Appeal

24. (Previously presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

25. (Previously presented) The method according to claim 24, wherein said step of transmitting from said remote site further comprises transmitting a link to a Web site of said retailer.

26. (Previously presented) The method according to claim 24, further comprising the step of determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

27. (Previously presented) The method according to claim 24, further comprising the steps of:

transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

transmitting from said Web site of said manufacturer to said remote site said selection data;

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

transmitting from said Web site of said manufacturer to said consumer computer said details.

28. (Previously presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

29. (Previously presented) The method according to claim 28, further comprising the steps of:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

30. (Previously presented) The method according to claim 28, further comprising the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

31. (Previously presented) The method according to claim 30, wherein said region data is postal code data.

32-35. (Canceled)

36. (Previously presented) A computer network implemented system, comprising:
means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

means for, in response to receipt of region data at said manufacturer's Web site,

transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

37. (Previously presented) The system according to claim 36, wherein said means for transmitting from said remote site said list further comprises means for transmitting a link to a Web site of said retailer.

38. (Previously presented) The system according to claim 36, further comprising means for determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

39. (Previously presented) The system according to claim 36, further comprising:

means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

means for transmitting from said Web site of said manufacturer to said remote site said selection data;

means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

means for transmitting from said Web site of said manufacturer to said consumer computer said details.

40. (Previously presented) A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives;

and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

41. (Previously presented) The system according to claim 40, further comprising:

means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

42. (Previously presented) The system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

43. (Previously presented) The system according to claim 42, wherein said region data is postal code data.

44-47. (Canceled)

48. (Previously presented) A computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

49. (Previously presented) A computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the

Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

50. (Previously presented) A computer implemented method comprising performing transactions involving multiple separate entities, including

transmission from the a consumer to a retailer website,

transmission from the retailer website to a remote website, and

transmission from the remote website to the retailer website, of a list of manufacturer incentives.

51. (Previously presented) A system comprising structure for performing transactions involving multiple separate entities, including:

mean for transmitting from the a consumer to a retailer website,

means for transmitting from the retailer website to a remote website, and

means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives.

Printed: July 2, 2004 (10:51am)

Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\AppealBrief040525.wpd

Attachment 1

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24



UNITED STATES PATENT AND TRADEMARK OFFICE

Review Date: 11/27/03

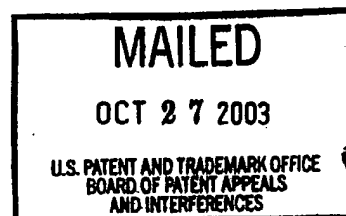
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

RECEIVED
JUL 14 2004
GROUP 3600

Appeal No. 2002-0329
Application No. 09/505,632

ON BRIEF



Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

RECEIVED

JUL 07 2004

Technology Center 2100

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-31, 34, 36-43, 46, 48 and 49.

The invention maintains a database of manufacturer offers and retailer special deals at a cooperative network site where consumers can access at least a subset of the data in the database from any manufacturer or retailer network site.

APDEC-CAT34SCROCCP-031103 CS

Appeal No. 2002-0329
Application No. 09/505,632

Accordingly, it makes little difference which site, whether manufacturer or retailer, that the consumer is logged in to when initiating the request since the data is received directly from the cooperative site. The result is that manufacturer offers and retailer special deals are exposed to many more consumers.

Representative independent claim 24 is reproduced as follows:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

The examiner relies on the following references:

| | | |
|--------|-----------|--|
| Smolen | 5,915,243 | Jun. 22, 1999 (filed Aug. 29, 1996) |
| Sloane | 5,918,211 | Jun. 29, 1999 (filed May 30, 1996) |

Appeal No. 2002-0329
Application No. 09/505,632

Hoffman et al. (Hoffman) 6,012,039 Jan. 4, 2000
(effectively filed Aug. 29, 1996)

Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C.
§ 102(e) as anticipated by Sloane.

Claims 24-27, 29-31, 36-39, 41-43, 48 and 49 stand rejected
under 35 U.S.C. § 103. As evidence of obviousness, the examiner
cites Sloane and Hoffman with regard to claims 24, 25, 27, 29,
36, 37, 39, 41, 48 and 49, adding Smolen to this combination with
regard to claims 26, 30, 31, 38, 42 and 43.

Reference is made to the briefs and answer for the
respective positions of appellants and the examiner.

OPINION

Turning, initially, to the rejection under 35 U.S.C.
§ 102(e), an anticipatory reference is one which describes all of
the elements of the claimed invention so as to have placed a
person of ordinary skill in the art in possession thereof. In re
Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Sloane discloses, at
column 7, lines 5-10, the transmission from a consumer computer
of a request for manufacturer incentives; at column 7, lines 13-

Appeal No. 2002-0329
Application No. 09/505,632

22, the transmission of region data from the website of a manufacturer in response to the request for manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacturer incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is

Appeal No. 2002-0329
Application No. 09/505,632

clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

Appeal No. 2002-0329
Application No. 09/505,632

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e).

With regard to claims 34 and 46, these claims are a bit broader in scope. They do not recite the separate communications of claims 28 and 40. In fact, claims 34 and 46 merely require a transmission from a manufacturer to a remote Web site regarding manufacturer incentive data, and then updating the manufacturer's incentives database, including graphical image data corresponding to the manufacturer's incentives.

Sloane clearly teaches, in Figure 3b, communicating manufacturer incentive data from the manufacturer to a remote Web site. The sender of promotional information, 16, may be a manufacturer (column 7, lines 11-13) and the information is sent to the consumer, at the retail computer 12, the retail computer 12 being remote from the manufacturer.

Appeal No. 2002-0329
Application No. 09/505,632

Clearly, the information in Sloane is sent over the internet (column 7, line 22). When the manufacturer transmits this information to computer/controller 12, the information is clearly an "update" of the manufacturer's incentives database. The examiner calls this feature "inherent" and we would agree.

The only limitation of claims 34 and 46 not explicitly, or implicitly, disclosed by Sloane is "graphical image data corresponding to said manufacturers incentives." The examiner calls this a "traditional practice to present data using a graphical user interface which presents graphical image data" (answer-page 4), and holding such a disclosure in Sloane to be inherent.

Appellants' position is that Sloane does not disclose updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (principal brief-page 10). While it may be "traditional" to present data using a graphical user interface which presents graphical image data over the internet, "this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data

Appeal No. 2002-0329
Application No. 09/505,632

corresponding to the manufacturers incentives, as in the claimed invention" (principal brief-page 10).

Since appellants do not deny that it is "traditional" to present data using a graphical user interface which presents graphical image data over the internet and Sloane clearly discloses storage of data defining manufacturers incentives by updating such information in a remote site via the internet, we will sustain the examiner's rejection under 35 U.S.C. § 102(e) since the consumer using the retailer computer/controller will be using a graphical user interface (GUI) to interface with the incentives information stored therein.

While we have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e), because appellants have not convinced us of error in the examiner's reasoning, it is our view that the rejection would have been stronger had it been made under 35 U.S.C. § 103 since, while not explicitly shown by Sloane, it would have been obvious for the consumer to interact with the retailer computer/controller via a GUI regarding the available manufacturers incentives. In any event, it would have been obvious to store the incentives "including graphical image data" since, as admitted by appellants, it is "traditional" to present data using a GUI.

Appeal No. 2002-0329
Application No. 09/505,632

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. § 103.

CONCLUSION

We have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e) but we have not sustained the rejection of claims 28 and 40 under 35 U.S.C. § 102(e) or the rejection of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 under 35 U.S.C. § 103.

Appeal No. 2002-0329
Application No. 09/505,632

Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

EK/RWK

Appeal No. 2002-0329
Application No. 09/505,632

NEIFIELD IP LAW, P.C.
2001 JEFFERSON DAVIS HIGHWAY
SUITE 1001
ARLINGTON, VA 22202